

Amendments to the Drawings:

The attached sheets of drawings include changes to Figures 2-3. These sheets, which include Figures 2-3, replace the original sheets including Figures 2-3.

Attachments: Replacement Sheets

REMARKS/ARGUMENTS

The above-identified application has been reviewed in light of the Office Action dated August 5, 2008. Claims 1-16 and 22 are currently pending. Claims 17-21 are withdrawn from consideration. Claims 1, 14, and 22 have been amended. Applicant reserves the right to file any future continuing applications, continuation or divisional. Applicant submits that these amendments add no new matter, are fully supported by the specification and are allowable over the prior art of record. In light of these amendments and the remarks that follow, early and favorable reconsideration of this application is respectfully requested.

Figures 2-3 of the drawings have been amended to be designated by a -Prior Art- legend in accordance with MPEP § 608.02(g) and 37 CFR 1.121(d). Accordingly, Applicant respectfully requests withdrawal of the objection to the drawings.

Claim 14 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 14 has been amended to depend from claim 1. Accordingly, Applicant respectfully submits that amended claim 14 particularly points out and distinctly claims the subject matter in accordance with 35 U.S.C. § 112. Therefore, reconsideration and allowance of claim 14 is respectfully requested.

Independent claims 1 and 22 have been amended to recite, *inter-alia*, the graduation is “configured and dimensioned to measure a distance between an end of the suture and the needle.” In the present case, the Applicant submits that each remaining independent claim patentably defines over the prior art, particularly as those claims have been amended

herein. The Applicant further submits that each dependent claim is allowable for all of the reasons that its respective base claim is allowable and because it adds patentable limitation thereto.

Claims 1-10, 14-16 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,478,344 to Stone et al. (hereinafter "Stone") in view of U.S. Patent No. 5,665,093 to Atkins et al. (hereinafter "Atkins"). Stone discloses an elongate member 3 having a proximal end and a distal end and a longitudinal axis; a pair of jaws 4, 5 at the distal end, at least one of the pair of jaws 4, 5 being movable, the pair of jaws 4, 5 each having a recess 15, 17 for receiving a suture carrying needle 14; needle retaining structure 15, 17 in each jaw of the pair of jaws 4, 5, the needle retaining structure 15, 17 extending from the respective jaw 4, 5 toward the proximal end; and a handle 2 at the proximal end including structure for alternately advancing and retracting the needle retaining structure 15, 17. Stone, however, does not disclose a scale with at least one graduation, nor does Stone disclose a graduation for measuring a distance between an end of the suture and the needle.

Atkins discloses an implanting apparatus having, *inter alia*, indicators 60 etched on the outside of a tubular member 22 for locating the position of the cuff 64 after the catheter 62 has been implanted in the tissue of the patient. The indicators 60 are designed to assist in *determining the location of the cuff*.

Consequently, the combination of Stone and Atkins fails to teach the currently amended claim limitations. The currently claimed invention envisions the unappreciated advantage of measuring a distance between an end of the suture and the needle. In other words,

looking at the independent claims as a whole, the purpose is to determine the length of the suture with respect to the instrument regardless of the depth of the instrument.

Conversely, any proper combination of Stone and Atkins at best suggests an instrument that determines a location of an attachment thereon, which is, in essence, strictly determining the depth of the inserted instrument. Applicant's invention solves a different problem than the references, and such different problem is recited as such in the currently amended claims. The problem solved, or determining the length of the suture, was never before recognized, as only hindsight bias can truly appreciate. Additionally, if the invention were in fact obvious, because of its advantages, those skilled in the art surely would have implemented it by now. That is--the fact that those skilled in the art have not implemented the invention, despite its great advantages, indicates that it is not obvious. Furthermore, even if one were to combine the references, one would still need to make modifications, not taught by the prior art, in order to combine the references in the manner suggested. Therefore, it is respectfully submitted that the presently claimed invention is patentable over the combination of Stone and Atkins.

Accordingly, and for at least these reasons, Applicant respectfully submits that the combination of Stone and Atkins fails to teach or suggest the surgical suturing apparatus recited in independent claims 1 and 22, and therefore, that claims 1 and 22 are in condition for allowance. As claims 2-10 and 14-16 depend, directly or indirectly, from claim 1, it is respectfully submitted that these claims are also in condition for allowance.

Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stone in view of Atkins and further in view of U.S. Patent 5,237,985 to Hodgson et al. (hereinafter "Hodgson"). Hodgson discloses, *inter alia*, a urine retractor having a shrink

wrapped cover 184 for identifying extension tubes 174, 176. The cover 184 is not a scale, but rather, is merely an identifying indicia of the article to which it is affixed: in this case, the extension tube 174, 176. In this case, the Applicant's invention solves a different problem than the reference, and such a different problem is recited in the claims. The volume indicia disposed thereon is also is not a scale, but rather is an instructional indicia which could be placed elsewhere as it is merely informational, e.g. in an instruction booklet, and still serve the same purpose. In other words, the placement location on the cover is irrelevant for purposes of measuring, whereas a scale placement location must be precise, as a scale deciphers differences between multiple quantities and volume indicia warns of a single quantity. In effect, this volume indicia as a scale is a very strained interpretation of the reference that could only be made by hindsight. Therefore, even if Hodgson was combined with Stone and Atkins, the references still would not meet the claim limitations because the intended functions of the references would be destroyed and therefore, the references are not legally combinable. Further still, even if these references could be combined, the references would produce an inoperative combination that would require necessary modifications, not taught in the prior art.

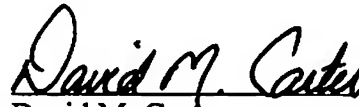
Furthermore, as discussed above, independent claim 1 is believed to be patentable. As claims 11-13 depend, directly or indirectly, from claim 1, it is respectfully submitted that claims 11-13 are at least patentable for the reasons independent claim 1 is patentable. Accordingly, withdrawal of this rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that all of the claims pending in the application are in condition for allowance. With this in mind, reconsideration and allowance of the specification and claims are respectfully requested.

Applicant believes that all issues raised in the Detailed Action have been responded to fully. Should the Examiner believe that an interview may facilitate the resolution of any outstanding issues, the Examiner is respectfully requested to telephone the Applicant's undersigned attorney at the number indicated below. Early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road - Suite 420
Melville, New York 11747
Tel.: (631) 501-5703
Fax: (631) 501-3526


David M. Carter
Reg. No. 30,949
Attorney for Applicants

Send correspondence to:
Chief Patent Counsel
Covidien
60 Middletown Avenue
North Haven, Connecticut 06473